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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,467	03/05/2004	Richard F. Wenstrom JR.	MIT5027USNP	2466

27777 7590 02/22/2010  
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NEW BRUNSWICK, NJ 08933-7003

EXAMINER
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HOFFMAN, MARY C

ART UNIT	PAPER NUMBER
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3733

NOTIFICATION DATE	DELIVERY MODE
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02/22/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jnjuspatent@corus.jnj.com  
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gsanche@its.jnj.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/708,467	<b>Applicant(s)</b> WENSTROM ET AL.	
	<b>Examiner</b> MARY HOFFMAN	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-18,34,35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-18,34,35 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 and 5-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites that the cutting edge is “not normal to the elongate member” in line 5. The originally filed disclosure does not disclose this claim limitation. The cutting edge (ref. #18a) extends circumferentially around the elongate member and is normal to the elongate member (see FIG. 2C). According to Applicant’s originally filed disclosure, the distal-facing surface (ref. #18c) or the proximally facing surface can be considered to extend “not normal” to the elongate member (see FIG. 2B).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 9-15, 34-35 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Russin (U.S. 5,807,276).

Russin discloses a tunnel notcher and guidewire delivery device, comprising an elongate member with proximal (e.g. FIG. 3) and distal (e.g. FIG. 2) ends and an inner lumen (ref. #34) extending therebetween, the inner lumen being adapted to receive a guidewire; and a cutting element (ref. #72) disposed proximal to the distal end of the elongate member and adapted to remove bone within an opening of a bone tunnel, the cutting element being substantially wedge-shaped and extending radially outward from the elongate member. The cutting edge (ref. #72) is spaced away from the elongate member and extends not normal to the angle member. A distal portion of the distal end of the elongate member is substantially tapered (ref. #22, sharpened edge). The cutting element is disposed proximal to the substantially tapered distal portion of the elongate member. The cutting element includes a distal-facing surface that is disposed at an acute angle with respect to a longitudinal axis of the elongate member. The cutting element includes a base portion (ref. #68) coupled to the elongate member and a cutting edge positioned a distance apart from the elongate member. The cutting edge is positioned distal to the base portion. The cutting edge that is positioned a distance apart from the elongate member has a length that is less than a diameter of the elongate member. The cutting element is adapted to create a notch in bone having a substantially semi-circular shape. The device further comprising a plurality of indicia (at ref. #36) formed on a distal portion of the elongate member and adapted to indicate a

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depth of the elongate member within a bone tunnel. The device further comprising a handle (ref. #'s 3, 40) disposed on a proximal portion of the elongate member. The handle extends in a direction transverse to a longitudinal axis of the elongate member. The distal portion (FIG. 2) has a length greater than a length of the cutting element (ref. #72).

### ***Response to Arguments***

Applicant's arguments filed 09/10/2009 have been fully considered but they are not persuasive.

Regarding claims 1 and 34, Applicant argues that the cutting edge of Russin does not meet the claim limitations of not extending normal to the elongate member and being spaced from the elongate member. The examiner respectfully disagrees. The cutting edge extends upward at an angle. Therefore, the cutting edge can be considered "not normal." Also, the cutting edge becomes increasing spaced away from the elongate member as it extends upwards. Therefore, the cutting edge can be considered "spaced away."

Regarding Applicant arguments that the device of Russin is a scalpel and therefore is not used for cutting bone, Applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the

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intended use, then it meets the claim. Russin can be used to cut bone, especially soft or small bones.

Regarding claim 35, the cutting element can be considered wedge-shaped, from a side profile. The width (note that the terms width, height, and depth are not defined in the claims) increases in a proximal to distal direction, when the proximal end is considered to be the back end and the distal end is considered to be the front end.

For the foregoing reasons, the rejections are deemed proper.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARY HOFFMAN whose telephone number is (571)272-5566. The examiner can normally be reached on Monday-Thursday 10:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mary C. Hoffman/  
Examiner, Art Unit 3733  
/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733